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Re:		
	Application No.:	**09/991,748**
	Confirmation No.:	**7030**
	Art Unit:	**3691**
	Appellants:	**Jeffery Enright, et al.**
	Title:	**Automated Banking Machine System and Method**
	Docket No.:	**D-1112 R4**

Sir:

In response to the Decision on Request for Rehearing dated September 23, 2010, please find enclosed a "Request for Clarification of Board Decision" for filing in the application.

No fee is deemed required. However, the Commissioner is authorized to charge any necessary fee associated with the Request and any other fee due to Deposit Account 09-0428.

Very truly yours,

Ralph E. Jocke
Reg. No. 31,029

CERTIFICATION UNDER 37 C.F.R. SECTIONS 1.8(a) AND 1.6(d)

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I hereby certify that, on the date shown below, this correspondence is being transmitted by facsimile to the Patent and Trademark Office at (571) 273-8300.

Date: 10/30/2010

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D-1112 R4

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appeal No.:	**2008-004397**	
In re Application of		
	Jeffery Enright	Art Unit 3691
Application No.:	**09/991,748**	
Confirmation No.:	**7030**	Patent Examiner Frantzy Poinvil
Filed:	**November 23, 2001**	
Title:	**Automated Banking Machine System and Method**	

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR CLARIFICATION OF BOARD DECISION

Sir:

The Appellant requests clarification of the Decision On Request For Rehearing dated September 23, 2010 ("Decision") by the Board of Patent Appeals and Interferences (hereinafter "Board") in Appeal No. 2008-004397.

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Issues Needing Clarification

The Appellant respectfully submits that the Decision is replete with errors, both structurally and legally. Appellant respectfully submits that the Decision would also be unclear to the Court of Appeals for the Federal Circuit ("CAFC"). Thus, clarifications regarding the Decision are first needed from the Board of Patent Appeals and Interferences ("Board") before the record is clear enough to enable the Appellant to address all of the issues before the CAFC.

1. Clarifications regarding language used in the Decision

1A). The Decision at page 13, lines 2-5, states that Appellant's Specification (at page 67, lines 5-7) reads "the user may indicate through one or more inputs through one or more input devices on the banking machine that their image or portion thereof will be their electronic image." However, the cited Specification section does not include "electronic image." Thus, clarification is requested. It appears that the Decision is based on consideration of the wrong language.

1B). The Decision at page 13, line 6, states that "According to the claim [1], the electronic image shall 'include' the image." However, claim 1 never mentions "electronic image." Thus, clarification is requested. It appears that the Decision regarding claim 1 is based on non existent claim language.

1C). The Decision at page 17, lines 16-17, states that "In the claimed method, the intended use of the image is to include it *and* the 'electronic signature.'" In the context of the paragraph in which it is being used, the Decision language is unclear. Please clarify

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whether this Decision language should read "In the claimed method, the intended use of the image is to include it *in* the electronic signature."

Similarly, the language "an ATM receiving an input indicative that a user agrees to include it *an* the 'electronic signature'" (at Decision page 17, lines 20-21) is unclear. Please clarify whether this latter Decision language should read "*in* the electronic signature."

1D). The Decision at page 24, lines 19-21, states that claim 37(d) reads "wherein the user identity data is linked so as to *server* as the electronic signature for the document." However, claim 37 actually reads "wherein the user identity data is linked so as to *serve* as the electronic signature *of the user* for the document." The term "server" is not present in claim 37. Furthermore, the Decision admits the actual claim language was not considered by the Board. Thus, clarification (for purposes of appeal to the CAFC) is requested.

1E). The Conclusion section of the Decision (at page 25) states that "We have carefully considered the arguments that the Appellant has set forth in the Request but, for the foregoing reasons, we do not find them persuasive as to error in the decision to affirm the rejection of claims 1, 6-15, 17-19, 21-27, 29, 33, and 35-38." Thus, the record indicates that since claims 1-39 were on appeal, by inference the rejection of claims 2-5, 16, 20, 28, 30-32, 34, and 39 is reversed. It follows that the Board's additional act to "reverse the rejection of claim 21" (Decision at last sentence) further infers that the Conclusion section should be clarified to state that the rejection of claims 2-5, 16, 20-21, 28, 30-32, 34, and 39 is reversed.

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2. **Issues regarding dictionary usage**

2A. As best understood, the Decision relies on two different dictionaries. The Decision (at page 21) relies on page 312 of the *Webster's New World Dictionary* (1988) for both "correspond" and "correlate." The Decision (at pages 22 and 24) relies on page 80 of the *Webster's New World Dictionary, 3rd College Edition* (1988) for both "ask" and "link." If the Decision is not relying on two different dictionaries, then clarification of the record is requested.

2B. It is unlikely that definitions for both "ask" and "link" are on the *same* page (e.g., indicated page 80) in a reliable dictionary. Thus, clarification of the record is requested.

3. **Issues regarding Decision reliance on new references**

Neither of the noted dictionaries (nor any of the definitions therefrom) was of record before the Decision. Thus, the Board's reliance on the newly presented definitions constitutes a new ground of rejection. The Board's attempt to bring these new references (and their definitions) in the back door while prosecution is closed is legally improper.

Appellant has not been given fair opportunity in any accordance with 37 C.F.R. 1.111 to properly rebut the Office's newly imposed basis for rejection. The Office is committing prejudicial error by depriving Appellant of his administrative due process rights (e.g., timely notice of the Office's position and opportunity for unhindered response thereto).

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The Appellant traverses the new definitions relied on by the Board. Appellant requests fair opportunity to provide evidence that these new definitions either are inaccurate or are not the most germane definitions to the person of ordinary skill in the art at the time of the invention.

Applicable Legal Standards

In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970)

> "Where a reference is relied on to support a rejection, whether or not in a 'minor capacity,' there would appear to be no excuse for not positively including the reference in the statement of rejection."

Ex parte Zhang, BPAI Appeal No. 2009-6959, pg. 4 n.2

> "The Examiner relies upon additional references in support of that argument . . . Because those references are not included in the statement of the rejection, they are not properly before us . . . Accordingly, we have not considered those references in reaching our decision."

Ex parte Kamboj, BPAI Appeal No. 2000-1779, pg. 89 n.64

> "we remind the examiner that 'where a reference is relied on to support a rejection, whether or not in a 'minor capacity,' there would appear to be no excuse for not positively including the reference in the statement of the rejection."

Ex parte Sabathie, BPAI Appeal No. 2000-1332, pg. 8 n.1

> "Where a reference is relied on to support a rejection, whether or not in a minor capacity, there is no excuse for not positively including the reference in the statement of the rejection."

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Ex parte Michael, BPAI Appeal No. 1997-0752, pg. 3-4

"If a prior art teaching is relied upon in any capacity to support a rejection, it should be positively included in the statement of the rejection."

Ex parte Raske, 28 USPQ2d 1304-05 (BPAI 1993)

"We therefore view the reference to Raviola and Mitsui, at page 4 of the Answer, as an improper effort to bring these references in the "back door." Compare In re Hoch, 428 F.2d 1341, 1342 n. 3, 166 USPQ 406, 407 n. 3 (CCPA 1970) . . . Raviola and Mitsui are not positively included in the statement of rejection, and we have considered the issue under 35 USC 103 based solely on the evidence contained in Ishikawa and Billmeyer."

USPTO Patent Bar Exam, October 15, 2003, afternoon session, question #42

Question: "The primary examiner has rejected claims 1-10 under 35 USC 103(a) as being unpatentable over the Smith patent in view of the Jones reference. Appellant properly argues that there is no motivation to combine the teachings of Smith and Jones. The examiner repeats the rejection of claims 1-10 as being "unpatentable over Smith in view of Jones." The examiner additionally cites a patent to Brown that was necessary to provide motivation for combining the teachings of Smith and Jones. The examiner does not list Brown in the statement of the rejection. Appellant timely appeals to the Board of Patent Appeals and Interferences, and files a proper appeal brief. The examiner files an examiner's answer addressing the rejection of claims 1-10 under 35 USC 103(a) as being unpatentable over Smith in view of Jones, and cites Brown in the argument as providing motivation to combine Smith and Jones. In accordance with the patent laws, rules and procedures as related in the MPEP, what will be the most proper decision of the Board?"

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Answer: "If the claimed invention is rendered obvious by Smith in view of Jones and Brown, the statement of rejection must include all three references. Reliance on Brown to support the rejection is a different rejection from a rejection relying only on Smith in view of Jones. In accordance with MPEP § 1208.01, the Board will not consider the teachings of Brown because Brown was used to support the rejection, but was not listed in the statement of the rejection. As stated in MPEP § 1208.01, 'Even if the prior art reference is cited to support the rejection in a minor capacity, it should be positively included in the statement of rejection. *In re Hoch* . . . The decision cannot affirm the rejection since there is no motivation for combining the teachings of Smith and Jones absent the teachings of Brown. Therefore, the rejection must be reversed, not affirmed."

4. **Issues regarding Decision reliance on new definition of "electronic signature"**

The definition of "electronic signature" provided at Finding of Fact 3 (at pages 3-4 in the initial decision dated September 22, 2009) was the definition of record at the time of Appellant's Request for Rehearing dated November 23, 2009. However, the Decision at page 8, lines 7-8, admits that this definition of "electronic signature" on which the Appellant's Request for Rehearing was based, has now been switched to a different definition. That is, the Decision is based on a (new) definition which is different from the (prior) definition that was used in both the initial decision and the Request for Rehearing.

The Board's reliance on this newly imposed definition of "electronic signature" constitutes a new ground of rejection. The Board's legally improper act is akin to switching all of the rejections while keeping prosecution closed. Appellant has not been

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given fair opportunity to properly rebut the Office's newly imposed basis for rejection. Again, the Office is committing prejudicial error by depriving Appellant of his administrative due process rights (e.g., timely notice of the Office's position and opportunity for unhindered response thereto).

Furthermore, the Board's act violates the fundamental legal principle that an administrative agency may not avoid review of its actions by engaging in repetitive activity which does not remain in place long enough to enable judicial review. *Southern Pacific Terminal Co. v. Interstate Commerce Com.*, 219 U.S. 498, 55 L.Ed. 310, 31 S. Cr. 279 (1911).

The Board somehow reasons that it can switch definitions in the middle of the appeal just by alleging that the new "definition does not appear to be substantively different from the one the Board applied in the Decision" (Decision at page 8, lines 9-10). However, this reasoning is incorrect and legally improper. What aspect of the appeal will the Board redefine next in order to meet its desired outcome?

Furthermore, even if Appellant had somehow based his Request for Rehearing on this different definition, the Board would have likely disregarded his arguments related thereto as not being pertinent to the definition of record. The Board can't have it both ways.

5. **Issues regarding Board inability to discern differences in subject matter**

As best understood, the Decision admits that the panel members are not qualified to render a proper decision concerning the recited subject matter. For example, the

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Decision at page 17, lines 17-21, admits that "We are unable to discern the difference between

[A] an ATM receiving an input indicative that a user agrees to have an image taken for customer approval as part of an electronic process for cashing a check

and

[B] an ATM receiving an input indicative that a user agrees to include it [an image] in [sic] the "electronic signature."

Appellant respectfully submits that the person of ordinary skill in the art at the time of the invention would be able to distinguish that agreeing to "have an image taken" (i.e., captured by Stinson's video camera 125) differs from agreeing to have an image included in an electronic signature. First, *taking* and *including* are two distinct (and mutually exclusive) terms. Second, all inputs received by an ATM are not equivalent to the ATM (which is apparently the opinion of the Board), otherwise the ATM could not perform different functions in response to the inputs.

One skilled in the art of patentably distinct subject matter (and restriction practice) would understand that the image in [A] can be used for purposes (e.g., ATM approving the customer) other than being included in an electronic signature. Also, the image in [B] does not need to be captured by a camera, e.g., it could be inserted into the ATM by a customer or it could already be stored in a data store associated with the ATM. As can be seen, [A] does not require [B], nor does [B] require [A]. As a result of the admission that the assigned Board panel is unable to discern the differences between [A] and [B], the Decision is legally improper.

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6. **Issues regarding Board failure to address all steps in claim 36**

The record shows that the Board has never fully addressed all of the steps in claim 36, especially step (b). The record shows that the Board continues to affirm the rejection of claim 36 based only on the features recited in claim 1. The record shows the following discussions regarding claim 36:

Appeal Brief (dated June 21, 2007)

"For reasons of brevity, Appellants' remarks in support of the patentability of the previous independent claims are incorporated herein by reference.

Where does Stinson have an ability to obtain user permission to use an electronic signature in processing a received check that is *needing* a user signature? Instead, Stinson simply returns to the user any check needing a user signature (col. 7, lines 53-57).

Where does Stinson teach operating a check-receiving automated banking machine to receive an agreement from the machine user for an image of the user to constitute the user's legally binding electronic signature for purposes of processing a check received by the machine?

Nor does Stinson teach operating the machine to correlate the check with a user image as the electronic signature of the user for purposes of processing the check. Where does Stinson operate an automated banking machine to correlate a user check with a user's image (as the user's electronic signature), especially for processing the check? For reasons previously discussed (e.g., claim 26), Stinson teaches away from correlating a check with a machine-captured user image as an electronic signature. There is also no evidence of record that Stinson's camera image (the alleged user image, as best understood) is ever correlated (with a check) as a user's electronic signature. Stinson does not anticipate claim 36.

Also, where does Stinson teach operating an automated banking machine (in which the document is received) to capture a user image? Stinson's ATM (350) does not operate the camera (125) to capture a user image. Rather, (as previously discussed with regard to claim 1, step c), Stinson teaches that it is the

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processor (300), not the ATM (350), that receives an image of the customer's face from the camera (125) (col. 5, lines 58-62). In other words, in Stinson the camera (125) is not part of the (document is receiving) ATM (350). It follows that Stinson also does not teach recited step (c). Again, Stinson does not anticipate claim 36." (Appeal Brief at pages 28-29).

Initial decision (dated September 22, 2009)

"The Appellant traverses the rejection of claim 36 for the same reasons as argued in regards to the rejection of claim 1 (App. Br. 28-29), and the Examiner also relies upon the same response as made in regards to claim 1 (Answer 5). Accordingly, because we found the Appellant's arguments unpersuasive with respect to claim 1, we find them equally unpersuasive with respect to claim 36." (decision at page 20).

Request for Rehearing (dated November 23, 2009)

"The Board states that 'Appellant traverses the rejection of claim 36 for the *same* reasons as argued in regards to the rejection of claim 1' and 'because we found the Appellant's arguments unpersuasive with respect to clam 1, we find them *equally* unpersuasive with respect to claim 36.' However, claim 36 is not *equal* to claim 1. For example, claim 36 has four steps, whereas claim 1 has only three steps. Nor are Appellants' claim 36 arguments the *same* as Appellants' claim 1 arguments. The record shows that the Board admits that it did not consider *all* of the language of claim 36, nor *all* of Appellants' claim 36 arguments. Thus, the Decision is admittedly defective."(Request at page 15).

Decision

"The Appellant would have us construe the claim such that the user's image is an electronic signature and that the input the ATM receives is indicative of an agreement that the image 'is' an electronic signature. While that may be what is disclosed in the Specification (see 67:5-7: 'the user may indicate through one or more inputs through one or more input devices on the banking machine that their image or portion thereof will be their electronic image [sic].'), that is not what is claimed." (Decision at pages 12-13).

"The Appellant argues that 'electronic signature' implies intent to have the 'image' constitute the user's legal signature. But such an argument presumes that image mentioned in the claim is the 'electronic signature'. The claim says instead that the user's 'electronic signature shall include data corresponding to at

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least one image of at least a portion of the user.' As we have already explained, the claim does not require the electronic signature to be an image but only to include one. Thus, the claim reasonably broadly covers a process that includes an image." (Decision at page 14).

"We did not overlook a limitation to the use of an image as an 'electronic signature' because that is not clearly recited in the claims. The Board in the prior decision did not find the claimed methods require the use of an image as an 'electronic signature.' Nor did the Board find that Stinson described an image which could be interpreted as and 'electronic signature.'" (Decision at page 14).

Claim 36

A method comprising:

(a) operating an automated banking machine to receive from a user of the machine a financial check needing signature from the user in order to be processed, wherein the machine includes a cash dispenser operative to dispense cash from the machine;

(b) operating the machine to receive agreement from the user that at least one image of the user constitutes a legally binding electronic signature of the user for purposes of processing the check;

(c) operating the machine to capture at least one user image of at least a portion of the user; and

(d) subsequent to (c), operating the machine to correlate the check with the at least one user image as the electronic signature of the user for purposes of processing the check.

As can be seen from the recited subject matter in claim 36, the Board's assertions (e.g., at Decision page 14) that: (1) the claims do "not require the electronic signature to be an image but only to include one"; (2) "a limitation to the use of an image as an 'electronic signature' . . . is not clearly recited in the claims; and (3) "The Board . . . did not find the claimed methods require the use of an image as an 'electronic signature'" are all incorrect and without merit.

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Claim 36 directly recites that the "*image* of the user *constitutes* a legally binding *electronic signature* of the user" (step b). That is, the user's image *is* the user's electronic signature. Thus, Board assertion (1) is not valid.

Claim 36 also recites "*correlate* the check with the at least one user image *as the electronic signature of the user* for purposes of processing the check" (step d). That is, the claim requires *use* of the user's image as the user's electronic signature. Nowhere does the Board ever address the claim 36 feature that the user image is *correlated as* (used as) the electronic signature of the user. In other words, in claim 36 the check is correlated with an electronic signature of the user (for purposes of processing the check), where the electronic signature *is* the user's image. At best, the Decision (at page 23) with respect to step (d) of claim 36 merely states that "we have reviewed the record but do not find the argument persuasive. Stinson describes taking an image of a user and the image that [sic] would appear to be in connection with a check provided by the user."

First, the Board's need to rely on "would appear" is evidence that a prima facie case of anticipation has not been established. Second, simply having a user image "in connection with a check" is not the same as correlating "as the electronic signature of the user", a user image with a check for purposes of processing the check. Third, the Board never even alleges that Stinson meets what is claimed. In order to meet the claim language the Board would have had to allege that "Stinson describes connecting the check with the user image as the electronic signature of the user for purposes of processing the check." For these many reasons, Board assertion (2) is not valid.

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In light of Board assertions (1) and (2) being invalid, Board assertion (3) in reality is an admission that not all of the features of claim 36 have been fully considered by the Board.

The Board also admits that "Nor did the Board find that Stinson described an image which could be interpreted as an 'electronic signature'" (Decision at page 14, lines 15-17). In light of Appellant's showing that claim 36 actually includes the features which the Board admits are absent in Stinson, the rejection of claim 36 must be reversed.

Again, nowhere in the record does the Board ever directly explain where Stinson teaches the features of claim 36, especially with regard to step (b) and step (d). As shown above in the citations, on one hand the Board indicates that claim 1 does not recite the (claim 36) features so they do not have to be addressed, yet on the other hand the Board uses the claim 1 language (not the claim 36 language) to affirm the rejection of claim 36. That is, because the Board finds Appellant's arguments unpersuasive with respect to claim 1, it simply states that it also finds them unpersuasive with respect to claim 36 even though the claim 36 language was never fully addressed. The Board improperly treated claim 36 to stand or fall with claim 1 even though these claims were separately argued.

Since the Board has not recognized nor addressed the differences (including the additional features) in claim 36 in comparison to claim 1, the Decision is incomplete (and thus defective) with respect to at least the subject matter of claim 36 (e.g., at least claim 26 also includes similar language). Appellant is still waiting for the Board to point out *any* teaching of using a machine user's image as the legally binding electronic signature of that user.

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7. **Issues regarding Board misinterpretation and misapplication of "electronic signature"**

The record shows that the Board provided a definition for "electronic signature" then watered downed this definition during its application to the claim language in order to have Stinson meet the recited features. For example, the Decision (at paragraph bridging pages 10-11) indicates that it applies "electronic signature" as an electronic process attached to a "contract or other record" that a person intends to sign", where Stinson's check constitutes the "contract or other record." This application is legally improper. The Board never applies the part of the definition where the process is executed or adopted (by a person) with the intent (as a purposeful action) to sign the record. That is, according to the definition, the person uses the process to sign the record.

The only "process" Stinson uses to sign a check (i.e., the "record" as alleged by the Board) is the manual (not electronic) handwriting process. The image of a user in Stinson is never used to *sign* a check. Even the Board admits that in Stinson the user "image is used to verify the identity of the depositor" (Decision at page 12, lines 12-13; also see Finding of Fact 14 and the Decision at page 17, lines 14-16). The person of ordinary skill in the art at the time of the invention would understand that the Board confuses using a person's image in authorizing a check cashing transaction with using a person's image to electronically sign a check (regardless of any check cashing transaction).

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Also, the Decision (at page 13, lines 14-16) alleges that "the Stinson process - endorsing, validating, and verifying the image via the ATM machine" meets "the 'electronic signature' as that claim term is ordinarily/customarily understood." Again the Board neglects to apply the entire definition of "electronic signature." The full definition requires that the "process" be "executed or adopted *by a person*." The Board has not explained how the two steps of "validating and verifying an image via the ATM" are performed *by a person*. The remaining step of "endorsing" a check is performed by a person. However, for the BPAI to allege that the act of a person providing a manually handwritten signature onto a paper check constitutes the person agreeing that their image captured by the ATM will constitute their electronic signature for the check is ludicrous.

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Conclusion

The Appellant has shown that there are several issues in the Decision that need to be clarified by the Board. Thus, Appellant's Request for Clarification should be granted.

It should be understood that the Appellant continues to respectfully disagree with the Decision's conclusion, and fully intends to continue the appeal process. As part of continuing that process, this Request for Clarification is being filed so the CAFC can review a clear record.

Respectfully submitted,

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